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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,869	09/21/2000	Thomas Vaughn Wilder	DAREDEV.018RA	4598

7590 08/02/2005

Knobbe Martens Olson & Bear  
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 Newport Beach, CA 92660-8016

EXAMINER
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FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/669,869		WILDER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Bryan Fischmann		3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 16-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3-29-05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

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***Acknowledgements***

1. The amendment filed 09-10-2004 has been entered.

***Oath/Declaration***

2. The reissue oath/declaration filed with this application is defective due to the following:

The declaration error is not recited well enough since it is not clear what the error is in the patent claims. Specifically, it needs to be clearly set forth what claim language and elements are unnecessary to practice the invention and which were irrelevant to allowance of the resulting patent as set forth in paragraph 5 of the declaration dated 04-30-2001 and which will be eliminated or modified in the new claims to correct this error. See Section 1414 of the MPEP.

Accordingly, claims 1-13 and 16-53 are rejected as being based upon a defective reissue declaration. See 37 CFR 1.175 and paragraph 1414 of the MPEP.

3. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

***Claim Rejections - 35 USC § 251***

4. Claims 13 and 16-53 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the

patent upon which the present reissue is based. See the 3<sup>rd</sup> and 4<sup>th</sup> paragraphs of 35 USC 251 and Section 1401 of the MPEP.

Note that an Amendment dated 3-19-1997 and an Examiner's Amendment dated 03-31-1998 in patent application 08/682,808, that was agreed to by applicant's representative, Jonathan A. Barney, that added the following limitations to claim 1 to overcome the prior art:

A) "integrally formed roller skate chassis"

B) "laterally spaced longitudinal members"

C) "generally planar upper portions with upper edges integrally attached...said heel and forefoot attachment members"

D) "one of said upper portions...being substantially coplanar with a respective lower portion"

E) "and integrally attached to said longitudinal members where said upper and lower portions intersect"

Note that the above Amendment also added the following limitations to claim 5:

A) "An integrally formed roller skate chassis"

B) "laterally spaced longitudinal members having upper edges integrally attached to said heel and forefoot members...longitudinal members having upper and lower generally planar portions"

C) "and attached thereto"

D) "convergent planes in an upwardly extending direction"

All these above limitations need to be present in the new claims (13 and 16-53). In many cases, they are not. Note, in particular, that the limitation, integrally formed roller skate chassis" is not present any of the new claims.

***Examiner's Comments***

5. Upon further review, the above additional defects in the application were noted by the PTO. It is regretted that these "defects" were not set forth earlier in prosecution of the application. Accordingly, this action is made non-final.


***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (571) 272-6694. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 7-12-5  
**BRYAN FISCHMANN**  
**PRIMARY EXAMINER**